

## **REMARKS**

Applicants acknowledge receipt of an Office Action dated May 11, 2007. In this response, Applicants have amended the specification as well as claims 1 and 9 to correct certain minor informalities noted by the PTO. In addition, Applicants have cancelled claims 2-4 and have incorporated the subject matter of these claims into independent claim 1 and have amended claims 1 and 5-9 to present the claims in a format more consistent with U.S. patent practice and U.S. english. In view of the amendments to claim 1, claims 2-4 have been cancelled without prejudice or disclaimer.

Following entry of these amendments, claims 1 and 5-9 remain pending in the application. Claims 7-8 have been withdrawn from consideration as being drawn to non-elected subject matter<sup>1</sup>. Thus, claims 1, 5-6, and 9 are pending and under consideration in this application.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

### **Remarks Responding to Examiner's Note**

Applicants note the PTO's statements regarding the meaning of L values in the CIE colorimetric system and wish to direct the PTO's attention to page 4, line 20 of the specification which states that the CIE LAB color space is based on JIS Z8729 (a Japanese Industrial Standard).

### **Claim Objections**

On page 2 of the Office Action, the PTO has objected to claims 1 and 9 for certain minor informalities. In this response, Applicants have amended claims 1 and 9 in a manner consistent with the PTO's suggestions regarding these claims. In view of these amendments, Applicants submit that the outstanding objections to claims 1 and 9 are now moot.

---

<sup>1</sup> Applicants, of course, have reserved the right to file a divisional application covering the non-elected subject matter and/or to receive consideration of claims to additional species as provided by 37 C.F.R. § 1.141, upon allowance of any claim that is generic.

## Specification

On page 2 of the Office Action, the PTO has objected to certain informalities. In this response, Applicants have amended the specification in a manner consistent with the PTO's recommendation. In view of these amendments, Applicants submit that the outstanding objection to the specification is now moot.

## Rejection Under 35 U.S.C. § 103

On page 3 of the Office Action, the PTO has rejected claims 1-5 and 9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over EP 0148718 to Panush (hereafter "Panush") in view of U.S. Patent 6,291,018 to Dattilo (hereafter "Datillo"). In addition, on page 5 of the Office Action, the PTO has rejected claim 5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Panush in view of Datillo and further in view of U.S. Patent 5,962,574 to Jackson *et al.* (hereafter "Jackson"). Applicants traverse these rejections for the reasons set forth below.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, Panush, Datillo, and Jackson, whether taken individually or in combination, fail to teach or suggest a method of coating a plastic part "wherein the primer paint comprises a color pigment which is present in an amount ranging from an amount equal to or more than 0.03 wt% to an amount equal to or less than 1 wt% relative to a solid content of the primer paint, wherein a hiding power of the color base coating is 30  $\mu\text{m}$  or more, and wherein a thickness X ( $\mu\text{m}$ ) of the primer coating is  $5 \mu\text{m} \leq X \leq 15 \mu\text{m}$ , and a thickness Y ( $\mu\text{m}$ ) of the color base coating is  $-X+20 \leq Y \leq 20$  when the film thickness X ( $\mu\text{m}$ ) of the primer coating is  $5 \mu\text{m} \leq X \leq 10 \mu\text{m}$  and  $10 \leq Y \leq -X+30$  when the film thickness X ( $\mu\text{m}$ ) of the primer coating is  $10 \mu\text{m} \leq X \leq 15 \mu\text{m}$ " as recited in amended independent claim 1. For at least this reason,

Applicants submit that the outstanding rejections based upon combinations of Panush, Datillo, and Jackson are improper and ought to be withdrawn.

As discussed in the paragraph bridging pages 4 and 5 of the present specification, if the content of the color pigment added to the primer paint is less than 0.03 wt%, the opacity becomes insufficient for the surface of the plastic parts. Furthermore, if the content of the color pigment exceeds 1 wt%, ill effects are incurred with respect to the adhesiveness and the weather resistance of the primer coating film. In addition, as shown in Figure 7, when the amount of the color pigment in the primer coating (2) was set to 1.5 wt%, the color difference AE became large (compare Example 1 and Comparative Example 2).

Furthermore, as discussed in the first full paragraph on page 5 of the specification, if the thickness of the primer coating film (2) is less than 5  $\mu\text{m}$ , the adhesiveness of the primer coating film (which is arranged between the top coat film and the plastic part) becomes insufficient, and the opacity for the surface of the plastic parts becomes inadequate. If the thickness of primer coating film (2) exceeds 15  $\mu\text{m}$ , the cost is increased due to overquality (see page 5, lines 8-14). In addition, as shown in Figure 7, if the thickness of primer coating film (2) was set to 20  $\mu\text{m}$ , the smoothness became poor (compare Example 1 and Comparative Example 5).

Panush discloses a coating composition comprising: a primer layer; a base coat; and a top coat, which contain a color pigment such as isoindolinone (see page 6, lines 1-3 and 15-18; Table 1; claim 3).

As shown in the table below, Panush discloses a pigment amount and a thickness of the topcoat and the base coat, however, Panush does not disclose the pigment amount and the thickness of the primary layer.

	Pigment amount	Thickness
Topcoat	Binder weight ratio of 0.002:1 to 0.30:1	1.5 to 3.0 mils (38 to 76 $\mu\text{m}$ )
Base coat	1 to 20 % by weight	0.4 to 2.0 mils (10 to 51 $\mu\text{m}$ )
Primer layer	-	-

As discussed above, the presently claimed pigment amounts and thickness of the primer coating (2) recited in amended claim 1 solve technical problems encountered by the present inventors. While Applicants acknowledge the PTO's statements regarding optimization of result effective variables and regarding concentration ranges, the PTO (1) has not yet established that the art recognizes the recited variables as being cause-effective and (2) has not established that the end point of any optimization would lead to the presently claimed ranges, as opposed to, for example, away from the presently claimed ranges.<sup>2</sup>

This also means that the PTO has failed to establish that the art suggests the desirability of the presently claimed invention. In this regard, Applicants wish to direct the PTO's attention to MPEP §2143.01(I) which is titled "THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION." (Emphasis Added). Here, the PTO's obviousness rejection establishes nothing with respect to the desirability of the proposed modification. Thus, Applicants submit that the PTO's reliance on optimization of a cause-effective variable is improper and ought to be withdrawn.

Applicants also note that Applicants specification includes comparative data which must be considered and addressed before reaching a determination that Applicants' claimed concentrations are non-critical. In view of this data, Applicants respectfully request reconsideration and withdrawal of the PTO's initial suggestion that the concentrations are allegedly obvious.

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 5-6 and 9, each of which ultimately depends from independent claim 1, are also non-obvious at least by virtue of their dependency from claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under § 103.

---

<sup>2</sup> It is never appropriate to rely solely on "common knowledge" without evidentiary support in the record, as the principal evidence upon which a rejection was based. *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). In this instance, if the PTO maintains the rejection of independent claim 1, in the interest of creating a complete record, Applicants respectfully request that the PTO cite the reference(s) upon which it relies.

**CONCLUSION**


Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 8/13/07  
FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5540  
Facsimile: (202) 672-5399

By   
Paul D. Strain  
Registration No. 47,369  
Attorney for Applicant